

### **REMARKS**

This is in response to the Office Action of October 3, 2007. The specification is amended to correct the designation of a compound structurally depicted on page 73, based on disclosure near the middle of page 72 of the specification ("compound (D)-1 describe below"). Claim 1 is amended based on disclosure in the specification – see pages 40-55 and 72. The dependency of claim 7 is corrected. Claims 9-11 are cancelled, without prejudice. No new matter is introduced by this Amendment. Claims 1-8 and 12-14 as amended are pending in this application.

#### **Rejection under 35 U.S.C. § 112**

Claim 7 was rejected under the second paragraph of 35 U.S.C. § 112 as including a feature which lacks antecedent basis in the claim from which it depends, claim 5. Office Action, page 2. Claim 7 has been amended to depend from claim 6 in order to overcome this ground of rejection.

#### **Rejections over Sugasaki in view of Shunichi**

Claims 1, 2, 4, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2003/0207204 A1 (Sugasaki) in view of JP 2003-22307 (Shunichi). Office Action, pages 3-4. Claim 3 was rejected as being unpatentable over Sugasaki in view of Shunichi and US 2002/0180944 A1 (Fujii). Office Action, pages 5-6. It is respectfully submitted that these grounds of rejection do not apply to claims 1-4 and 12 in their current form. Claims 1-4 and 12 each requires an undercoat layer which includes a compound having a polymerizable group, a group of the formula  $-\text{OPO}_3\text{H}_2$ , and a group of the formula  $-(\text{OCH}_2\text{CH}_2)_n-$  between the support and the image recording layer. Neither Sugasaki nor Shunichi nor Fujii teaches or suggests an undercoat layer having those features. Accordingly, the inventions of claims 1-4 and 12 are not rendered unpatentable by any combination of Sugasaki, Shunichi, and Fujii.

Rejections over Sugasaki

Claims 5, 8, 9, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugasaki alone. Office Action, pages 6-7. Claims 6-7 were rejected as being unpatentable over Sugasaki in view of US 6,495,309 B1 (Brabbs). Office Action, pages 8-9. Claim 10 was rejected as being unpatentable over Sugasaki in view of Brabbs and WO 02/076739 A1<sup>1</sup> (Hiller). Office Action, pages 9-10. Claim 11 was rejected as being unpatentable over Sugasaki in view of US 2003/0160207 A1 (Sakaguchi). Office Action, page 10. The rejections are respectfully traversed.

A key part of these rejections is the Examiner's assertion, at the top of page 7 of the Office Action, that "Polyvinylphosphonic acid meets the limitations for the compound (D) of the instant application, having an ethylenically unsaturated double bond (polymerizable group) and a phosphonic acid group (support adsorbative group)."

However, polyvinylphosphonic acid does not have an ethylenically unsaturated double bond. Polyvinylphosphonic acid is synthesized by polymerizing the vinyl group of vinylphosphonic acid. This results in a compound which has a repeating moiety that has the formula  $-\text{CH}_2\text{CH}(\text{PO}_3\text{H})-$ . In other words, the vinyl group in the monomer becomes a saturated group in the polymer.

Accordingly, the rejections of claims 5-8, 13, and 14 over Sugasaki, Brabbs, Hiller, and Sakaguchi as set forth on pages 6-10 of the outstanding Office Action should be withdrawn.

Conclusion

Entry of the above amendments is earnestly solicited. An early and favorable reconsideration of the merits of claims 1-8 and 12-14 in their present form is earnestly solicited.

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<sup>1</sup> US 6,935,236 B2 is cited as an English-language equivalent of the German language Hiller reference.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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